

## Remarks

Claims 1-6, 8 and 11 have been amended, new claim 13 has been added and claims 7, 9, 10 and 12 have been cancelled without prejudice or disclaimer of the subject matter encompassed therein. The amendments to the claims remove parenthetical subject matter and place the claims in a format more reflective of standard U.S. patent practice. New claim 13 finds support in the specification at, *inter alia*, Examples 1-52. The new claim and the amendments to the claims do not introduce prohibited new matter.

### 1. Rejection under 35 U.S.C. 112, second paragraph

- Claims 1-4 are rejected due to the inclusion of parentheses within the claims.

Applicants have amended the claims to remove all parenthetical subject matter.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

- Claims 1 and 7 are rejected due to the recitation of “I” and “R1R”.

Applicants have amended claims 1 and 7 to remove the contested terms. Accordingly, Applicants respectfully request that this rejection be withdrawn.

- Claim 1 is rejected due to recitation of the phrase “substituted phenyl” without the recitation of specific substituents.

Claim 1 has been amended to recite specific substituents. Accordingly, Applicants respectfully request that this rejection be withdrawn.

- Claim 7 is rejected due to the recitation of the phrase “a group that can be subsequently reacted to form R1R” and the phrase “subsequently removing the protecting groups as necessary”.

Claim 7 has been amended to remove the contested phrases. Accordingly, Applicants respectfully request that this rejection be withdrawn.

- Claim 12 is rejected due to the recitation of a use without reciting any active steps.

Claim 12 has been cancelled without prejudice or disclaimer of the subject matter encompassed therein. Accordingly, Applicants submit that this rejection has been effectively mooted.

**2. Rejection under 35 U.S.C. 112, first paragraph**

- Claims 1-7 and 12 are rejected due to the Examiner's assertion that the specification, while being enabling for making salts of the claimed compounds, does not reasonably provide enablement for making solvates and hydrates of the claimed compounds.

While Applicants submit that the preparation of solvates of these compounds is well within the skill of the person skilled in this art, in order to expedite the allowance of this application all reference to "solvates" has been removed from the claims thereby obviating this ground for rejection. The reference to "solvates" is, in any event, considered to be unnecessary inasmuch as a claim to the compound(s) per se would encompass all solvate forms thereof just as it would compass all hydrates, polymorphous, enantiomers, *etc.* Therefore the removal of the term "solvates" does not, and is not intended to, reduce the scope of the claims in any respect.

- Claim 12 is rejected due to the Examiner's assertion that the specification, while being enabling for treating specific diseases, does not reasonably provide enablement for prevention or prophylaxis of diseases.

Without acquiescing to the merits of this rejection, claim 12 has been cancelled without prejudice or disclaimer of the subject matter encompassed therein, thereby effectively mooting this rejection.

**3. Rejection under 35 U.S.C. 101**

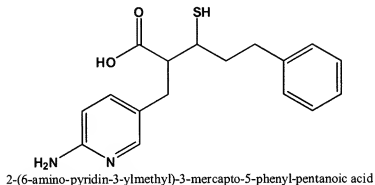
Claim 12 is rejected due to the recitation of a use without reciting any active steps.

Claim 12 has been cancelled without prejudice or disclaimer of the subject matter encompassed therein, thereby effectively mooting this rejection.

4. **Rejection under 35 U.S.C. 102(b)**

Claims 1-7 and 12 are rejected as allegedly anticipated by WO 00/66557 to Linschoten *et al.* ("Linschoten"). The Examiner asserts that the compound described on page 86, example 31 (identified by the Examiner as 2-(6-amino-pyridin-3-ylmethyl)-3-mercapto-5-phenyl-pentanoic acid) is identical with Applicants' claims.

Applicants submit that the claims do not anticipate the compound cited by the Examiner for at least the reason that the cited compound contains both a 6-amino-pyridin-3-ylmethyl moiety and an unsubstituted phenyl group (as depicted below), while in contrast, Applicants'



independent claim 1 contains a proviso that when R<sup>2</sup> is 6-aminopyridin-3-yl then R<sup>1</sup>, when R<sup>1</sup> is phenyl, must be a substituted phenyl (*i.e.*, a phenyl substituted by 1, 2 or 3 substituents selected from halogen, hydroxy, cyano, C<sub>1-4</sub> alkyl, C<sub>1-4</sub> alkoxy, CF<sub>3</sub>, OCF<sub>3</sub>, methylenedioxy, C(O)R<sup>3</sup>, S(O)<sub>2</sub>R<sup>4</sup>, phenyl, phenoxy and tetrahydrofuranoxy). This proviso was part of claim 1 as originally filed and therefore does not constitute prohibited new matter. Accordingly, Linschoten does not anticipate Applicants' claims and therefore Applicants respectfully request that this rejection be withdrawn.

5. **Allowability**

The Examiner indicates that the elected species (2-[(6-aminopyridin-3-yl)methyl]-5-(3-chlorophenyl)-3-mercaptopentanoic acid) is allowable.

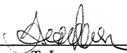
6. **Conclusion**

The foregoing amendments and remarks are being made to place the application in a condition for allowance. Applicants respectfully request reconsideration of and the timely allowance of the pending claims. The Examiner is invited to telephone the undersigned at the Examiner's convenience if needed to further prosecution of this application.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,  
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